

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MARK D. MONTIERTH, RICHARD D. TAYLOR
and GARY ZIMMERMAN



Appeal No. 2006-1604
Application No. 09/903,201

ON BRIEF

Before JERRY SMITH, RUGGIERO and MACDONALD, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-15.

The disclosed invention pertains to a system for providing point-of-sale demonstrations for computer peripherals, such as printers.

Representative claim 1 is reproduced as follows:

1. For a peripheral that during normal operation, connects to a host computer through a cable containing a controller, a demonstration system comprising:
 - a controller of a type employed in the cable that connects the peripheral to the host computer during normal operation; and
 - a memory that is external to the peripheral, contains demonstration data, and is coupled to the controller to enable the controller to read the demonstration data from the memory for the peripheral to perform a demonstration without being connected to the host computer.

The examiner relies on the following references:

Wett	5,872,945	Feb. 16, 1999
Farago	6,747,752	June 8, 2004 (filed Nov. 6, 1998)
Lin	6,753,903	June 22, 2004 (filed Sep. 9, 1999)

The following rejections are on appeal before us:

1. Claims 1-6 and 10-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Lin in view of Farago.

2. Claims 7-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Lin in view of Farago, and further in view of Wett.

Rather than repeat the arguments of Appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the Appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon by the examiner does not support the examiner's rejections of claims 1-15. Accordingly, we reverse.

We consider the obviousness of the following logical groups of claims, as argued separately by Appellants:

- GROUP I, claims 1-6 and 10-15.
- GROUP II, claims 7-9.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. "Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on

evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189

USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

GROUP I, claims 1-6 and 10-15

We consider first the examiner's rejection of claims 1-6 and 10-15 that stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Lin in view of Farago. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider independent claim 1 as the representative claim for this rejection.

We note that the primary Lin reference teaches an adaptor for connecting a digital still camera directly to a printer. Lin's invention thus provides the capability of printing photos directly from a digital camera without using a personal computer [Lin, col. 2, lines 38-46]. The examiner relies upon Lin as teaching all the elements of the claimed invention except the limitation of "a memory containing demonstration data for controlling the peripheral to perform a demonstration" [answer, page 4]. The examiner

relies upon Farago for its teaching of a memory containing demonstration data, as claimed [answer, page 4]. The examiner further relies upon Wett for teaching a second mode of operation wherein the controller boots from an external memory, as claimed (claim 7) [answer, page 8].

Appellants argue that independent claims 1 and 11 distinguish over the combination of Lin and Farago because Lin and Farago do not teach nor suggest using a controller in a cable that connects a host computer to a peripheral [reply brief, page 5, brief, page 3].

In response, the examiner asserts that: "Lin teaches cables 4 & 5 containing adaptive circuitry 1. Therefore, the cable + functional circuitry of Lin as well as other cables + functional circuitry read on applicant's described definition of a 'cable' " [answer, page 4].

We note that the examiner relies solely upon Lin for allegedly teaching the claimed "controller of a type employed in the cable" (independent claim 1) and the "cable containing a controller" (independent claim 11).

"During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification." In re

Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1358, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999). The words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. "When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art." In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

We note that the plain meaning of the language recited in independent claim 1 explicitly requires the controller to be "in the cable." Likewise, independent claim 11 explicitly requires a "cable containing a controller." We note that there is no language found in the instant specification that disclaims or disavows the plain meaning argued by Appellants in the briefs. The instant specification discloses: "a printer that has a controller integrated in a printer cable" [specification, page 2, ¶0007]. The instant specification further discloses: "A printer cable 120 that connects host computer 110 to printer 130 includes a controller 128 that acts as a formatter" [specification, p. 4, ¶0014]. Finally, the instant specification discloses: "In alternative

embodiments, demo pod 210 can be part of a molded cable including controller 128 and demo pod 210 ..." [specification, page 4, ¶0016].

We therefore find that the broadest reasonable interpretation of the claim language that is consistent with the specification requires a controller that is an integral part of a cable assembly. We also find that the interpretation argued by Appellants is consistent with the interpretation that those skilled in the art would reach.

The examiner relies upon the Lin patent for its teaching of a multi-processing micro-controller 11, as shown in fig. 1. [answer, page 3]. Lin clearly shows in fig. 1 an Adapter 1 (as shown in the dotted rectangle that includes multi-processing micro-controller 11) that is connected to USB digital still camera 2 via cable 4. Likewise, cable 5 is clearly shown connecting the USB Printer Port 15 of Adapter 1 to the USB Printer 3 [Fig. 1]. The Lin patent specification confirms that Adapter 1 (which includes multi-processing micro-controller 11) is not an integral part of a cable, as required by the instant claims:

See Lin, col. 2, lines 53-67 (emphasis added):

As shown in FIG. 1, a USB-DSC port 14 of the adaptor 1 is connected with the USB-DSC 2; the coupling between the USB-DSC port 14 and the USB-DSC 2 is a USB

cable 4. Since the adaptor 1 is functioning as a host under the USB platform, the connector of the USB cable 4 adjoining the USB-DSC port 14 is a Type-A connector, and the connector of the USB cable 4 adjoining the USB-DSC 2 is a Type-B connector. Similarly, a USB printer port 15 of the adaptor 1 is in connection with the USB printer 3; the coupling between USB printer port 15 and USB printer 3 is a USB cable 5. Since the adaptor 1 is functioning as a host under the USB platform, the connector of the USB cable 5 adjoining the USB printer port 15 is a Type-A connector, and the connector of the USB cable 5 adjoining the USB printer 3 is a Type-B connector.

Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a *prima facie* case of obviousness with respect to the claims under appeal. A controller that is an integral part of a cable assembly, as discussed *supra*, is not taught nor fairly suggested by the references cited by the examiner. We therefore agree with Appellants that every limitation is not taught by the combination of references relied upon by the examiner. Whether it would have been obvious to one of ordinary skill in the art at the time of the invention to combine a controller, such as that taught by Lin, with a cable where the controller is employed "in the cable, " as claimed is a question which is not before us.

With respect to **Group II**, claims 7-9, we note that because these claims contain all the limitations found in independent claim 1, we need not reach the other questions presented by Appellants in the briefs.

Accordingly, we will not sustain the examiner's rejections of claims 1-15. Therefore, the decision of the examiner rejecting claims 1-15 is reversed.

REVERSED

Jerry Smith

Jerry Smith
Administrative Patent Judge

Joseph F. Ruggiero

Joseph F. Ruggiero
Administrative Patent Judge

Allen R. MacDonald

Allen R. MacDonald
Administrative Patent Judge

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Appeal No. 2006-1604
Application No. 09/903,201

Page 13

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